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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONATHAN BARSADE,
STEVEN Y. CHO,
and
ADAM ZELL

Appeal 2009-0419
Application 09/867,223
Technology Center 3600

Decided:¹ April 30, 2009

Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-42. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a banner ad which is viewed between requested web pages, i.e., it is viewed during the time period in which a first web page is being removed from a browser window and a requested second web page is being downloaded onto a computer and ready for viewing in the browser window (Spec. 3:26-29). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method of providing to a user computer connected to a network an advertisement for a network browser session, the method comprising the steps of:
 - a) requesting a new network data stream for display in the first network browser session;
 - b) serving up to a second network browser session an advertisement data stream previously stored in the memory of the user computer connected to the network thereby forming an advertisement;
 - c) downloading to the user computer, from a server on the network, the requested new network data

stream which is viewable in the first network browser session;

wherein, the advertisement is served up while the new network data stream is being downloaded to the user computer and in association with a displayable status indicator of the concurrent downloading activity of the new network data stream, the advertisement data stream was downloaded onto the memory of the user computer prior to the step of requesting a new network data stream, and the first and second network browser sessions are the same session or different sessions.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Slotznick	US 6,011,537	Jan. 4, 2000
Slotznick	US 6,609,146 B1	Aug. 19, 2003

The following rejections are before us for review:

1. Claims 1-42 are rejected under 35 U.S.C. § 103(a) as unpatentable over Slotznick '537 in view of Slotznick '146.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejection of the claims.

This issue turns first with regard to claims 1-42 on whether it would have been obvious to combine Slotznick '537 and Slotznick '146 under 35 U.S.C. § 103(a) to have the advertisement "served up...in association with a

displayable status indicator of the concurrent downloading activity of the new network data stream.”

This issue turns second with regards to claims 31-42 on whether the combination of Slotznick ‘537 and Slotznick ‘146 under 35 U.S.C. § 103(a) discloses a “banner activation code.”

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1. Slotznick ‘537 discloses displaying secondary information or a banner image in place of the primary requested information during the delay period which occurs upon request by the user of subsequent primary information or upon direct request by the user of the full secondary information (Col. 25:32-Col. 26:4).

FF2. Slotznick ‘537 discloses that a “page” is downloaded and may contain primary and secondary data. The page may contain software (in any form, language or code), programs, and scripts (Col. 8:44-63).

FF3. Slotznick ‘537 discloses that primary data is the virtual page (Col. 9:66-10:5) and that the secondary information may include advertisements such as banner ads on the Internet (Col. 24:35-38).

FF4. Slotznick ‘537 discloses that the secondary information is contained in the primary information (Col. 9:66-10:5).

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF5. Slotznick '146 discloses that some programs post estimated processing times (particularly for downloads which can take hours) (Col. 4:23-25).

FF6. Slotznick '146 discloses that instead of blocking all advertisements, the device may selectively block or filter information (Col. 5:13-15).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415, (citing *Graham*, 383 U.S.

at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

ANALYSIS

Arguments Concerning the Failure to Disclose Advertisements Shown in Association with Status Indicator

The Appellants argue that the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Slotznick ‘537 in view of Slotznick ‘146 is improper. Claim 1 includes the limitation that the advertisement is “served up...in association with a displayable status indicator of the concurrent downloading activity of the new network data stream.” The Appellant

argues that while Slotznick '146 provides for some programs an estimate of the processing time, there is no suggestion of this processing time being shown in association with an advertisement (Br. 5). Further, the Appellants argue that Slotznick '146 teaches away from displaying an advertisement during processing by discussing blocking interstitial advertisements (Br. 5-6)

In contrast the Examiner has determined that the combination of Slotznick '537 in view of Slotznick '146 discloses all the claimed limitations of claim 1 and that it would have been obvious to combine the references to inform the user of the download times (Ans. 3-4). The Examiner argues that the Appellants' arguments of nonobviousness presented in the Appeal Brief have been made only by attacking the references individually (Ans. 8).

We agree with the Examiner. Slotznick '537 discloses displaying secondary information or a banner image in place of the primary requested information during the delay period which occurs upon request by the user of subsequent primary information (FF1) and the Appellants have not disputed this. Slotznick '146 discloses posting estimated processing times during downloads (FF5).

The Appellants argued that Slotznick '537 and Slotznick '146 should not be combined because Slotznick '146 teaches blocking advertisements but we do not find this convincing. Slotznick '146 discloses that not all advertisements may be blocked since this blockage can be done selectively (FF6). Regardless, Slotznick '146 has been used in the rejection only as a teaching that the display of estimated processing times was known in the art, and the Appellants have attacked the references individually rather than address the combined teachings. It is improper to attack references individually where, as here, the obviousness rejection is based on their

combined teachings. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425-26 (CCPA 1981).

The modification of the system of Slotznick '537 to include posting estimated processing times as disclosed by Slotznick '146 is an obvious and predictable use of prior art elements according to their established functions to enable the user to determine how much time is left before the download is complete. For these reasons the Appellants' arguments to show error in the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Slotznick '537 in view of Slotznick '146 are not persuasive. The Appellants have presented these same arguments for claims 2-42 and error is not found for the rejection of these claims in this regard for the same reasons given above.

*Arguments Concerning the Failure to Disclose a
Banner Ad Activation Code*

The Appellants argue that the rejection of claims 31-42 under 35 U.S.C. § 103(a) as unpatentable over Slotznick '537 in view of Slotznick '146 is improper because the references fail to disclose the claimed limitations for a "BA activation code" (which refers to a "banner ad activation code"). The Appellants also argue that Slotznick '537 fails to disclose that two requests are made to obtain a web page with an advertisement: first, a request for a data stream and a BA activation code, and second, that the BA activation code initiate a request for the advertisement (Reply Br. 3-4).

In contrast the Examiner has determined that Slotznick '537 discloses such a "banner activation code" by disclosing 1) that the page includes "software (in any form, language or code)" and "any data encoded or compressed form" and 2) that secondary information (including

advertisements) is contained in the primary information (or primary data or virtual page) (Ans. 9-10). The Examiner has determined that Slotznick discloses that the primary information includes code embedded in the page which provides for the request of secondary information (the banner ad).

We agree with the Examiner. Slotznick '537 discloses that a webpage or "page" contains primary and secondary data and may contain software (in any form, language or code), programs, and scripts (FF2). Slotznick '537 also discloses that the secondary information may include advertisements such as banner ads on the Internet (FF3). Thus, Slotznick discloses that banner ads (FF3) (which are secondary information) have codes or scripts (FF2) which must serve as "banner ad activation codes" since codes or scripts would be required to display or "activate" the banner ads on the webpage. Slotznick '537 requires a first request for a web page which would generate and a second request for information for the banner ad content from an appropriate server. For these reasons the arguments made by the Appellant to show error in the rejection of claims 31-42 under 35 U.S.C. § 103(a) as unpatentable over Slotznick '537 in view of Slotznick '146 are not persuasive.

CONCLUSIONS OF LAW

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 1-42 under 35 U.S.C. § 103(a) as unpatentable over Slotznick '537 in view of Slotznick '146.

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DECISION

The Examiner's rejection of claims 1-42 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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